

**THIS DISPOSITION IS NOT
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OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mannington Carpets, Inc.

Serial No. 76/328,230

Sherry H. Flax of Saul Ewing LLP for Mannington Carpets,
Inc.

Mary Boagni, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Simms, Cissel and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Mannington Carpets, Inc. seeks registration of the mark
LIFELINES on the Principal Register for goods identified as
"resilient vinyl floor coverings" in International Class 27.¹

This case is now before the Board on appeal from the
final refusal to register based upon Section 2(d) of the
Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining

¹ Application Serial No. 76/328,230, filed on October 23, 2001,
is based upon applicant's allegation of a *bona fide* intention to
use the mark in commerce. On March 22, 2002, applicant filed an
amendment to allege use claiming January 1, 2002 as the date of
first use of the mark anywhere and in interstate commerce.

Attorney has held that applicant's mark, when used in connection with resilient vinyl floor coverings, will so resemble the mark LIFELINES that is registered for "wallcovering made primarily of plastic," also in International Class 27,² as to be likely to cause confusion, to cause mistake or to deceive.

Responsive to the refusal to register, applicant argues that there would be no likelihood of confusion in this instance because neither registrant nor applicant has diversified into each other's specific goods, the Trademark Examining Attorney has provided no evidence as to the fame of registrant's mark, and applicant's goods are sold by sales representatives to sophisticated purchasers working for institutions such as hospitals and nursing homes.

By contrast, the Trademark Examining Attorney contends that both products are used for "interior construction or remodeling type purposes" (Trademark Examining Attorney appeal brief, unnumbered page 5), that the record demonstrates that these respective goods move in the same channels of trade, and that there is no requirement for the Trademark Examining Attorney to prove the fame of a registered mark in a setting such as this.

² Registration No. 1,904,522, issued on July 11, 1995, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The du Pont case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion. In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

As noted by the Trademark Examining Attorney herein, applicant has adopted as its mark the word LIFELINES - which is identical in every way to registrant's prior mark. Hence, when both registrant and applicant are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc.

v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Accordingly, we turn to the similarity or dissimilarity and nature of the goods as described in the application and cited registration. Registrant's product is designed to cover walls, while applicant's product is intended to cover floors. Both are made of similar materials. Vinyl is a type of plastic. Applicant concedes that these goods may well "coexist in the same broad industry" but argues that the record does not demonstrate that sophisticated purchasers would assume that vinyl floor coverings and plastic wallcoverings originate with the same source, even when sold under identical marks. We disagree.

The record contains ample evidence of the relatedness of these goods. Excerpts from Lexis/Nexis, from Thomas' Register and from specific sites on the Internet all demonstrate that the same manufacturers and merchants make and sell plastic wallcoverings and vinyl floor coverings. The file also contains more than a dozen third-party federal trademark registrations where the same mark is registered

for both wallcoverings and floor coverings. While such registrations are admittedly not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

The fact that applicant has never decided to expand into wallcoverings and that perhaps registrant has never expanded into floor coverings is not relevant to our inquiry. Rather, the record shows clearly that other manufacturers and merchants make and sell both forms of interior decorating materials.

As to the similarity of established, likely-to-continue trade channels, applicant argues that its vinyl floor coverings will be marketed in distinct channels of trade - to institutional purchasers such as hospitals and nursing homes. However, we note that the goods are identified with no restrictions as to trade channels or purchasers in either the application or the registration. The Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the

registration. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, the Board must consider that registrant's and applicant's respective goods could be offered and sold to the same class of purchasers through all normal channels of trade. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

Similarly, when considering the conditions under which and buyers to whom sales are made, applicant argues its purchasers will be careful, sophisticated purchasers. Applicant makes no showing in support of this allegation, and it certainly does not follow from the identification of goods. Accordingly, we must assume that applicant and registrant are both marketing their respective goods to the same group of ordinary purchasers. Moreover, when the marks are identical in every respect, even sophisticated purchasers may be prone to confusion when the same term is used on such closely related goods.

As to the fame of the prior mark, applicant is correct that the file contains no information on this point. However, the term LIFELINES appears to be arbitrary as applied to wallcoverings, and hence is inherently distinct

as a source indicator. In an *ex parte* context such as the instant case, involving as it does identical marks applied to related goods, where there has been no indication of any weakness in the cited mark, it is clearly not incumbent upon the Trademark Examining Attorney to demonstrate that the cited mark has attained some degree of fame in order to prevail when applying the du Pont factors. Although our primary reviewing court has held that the fame of a registered mark is relevant to likelihood of confusion, the converse is not true, i.e., likelihood of confusion is not precluded by a registered mark's not being famous. In re Majestic Distilling Co., __ F.3d __, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

In conclusion, with identical, inherently distinctive marks applied to related goods that move in the same channels of trade to the same ordinary purchasers, all the relevant du Pont factors favor an affirmance of the Trademark Examining Attorney's refusal to register herein.

Decision: The refusal to register under Section 2(d) of the Trademark Act is hereby affirmed.